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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/939,406	08/24/2001	Ben-Zion Dolitzky	1662/49603	5473

26646 7590 05/28/2003

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NEW YORK, NY 10004

EXAMINER
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BERNHARDT, EMILY B

ART UNIT	PAPER NUMBER
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1624

DATE MAILED: 05/28/2003

14

Please find below and/or attached an Office communication concerning this application or proceeding.

# Advisory Action

Application No.  
09/939,406

Applicant(s)  
DOLITZKY et al.

Examiner  
Emily Bernhardt

Art Unit  
1624



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 4/10/03 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

Therefore, further action by the applicant is required to avoid the abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

THE PERIOD FOR REPLY [check only a) or b)]

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 4/10/03. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see NOTE below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See attached response.

3. ☒ Applicant's reply has overcome the following rejection(s):  
The Terminal disclaimer filed 4/10/03 has been entered and approved and thus overcomes the obviousness DP rejection over US'156.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
\_\_\_\_\_
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
- The status of the claim(s) is (or will be) as follows:
- Claim(s) allowed: \_\_\_\_\_
- Claim(s) objected to: \_\_\_\_\_
- Claim(s) rejected: 1-36, 49, 51-63, and 65
- Claim(s) withdrawn from consideration: \_\_\_\_\_
8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
10. ☐ Other: \_\_\_\_\_

*E. Bernhardt*  
EMILY BERNHARDT  
PRIMARY EXAMINER  
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The after final amendment cannot be entered for more than one reason.

While the amendment may overcome the 112 rejections under par. two as urged by applicants, the narrower claims now amended to exclude prior art rejections of the previous action would necessitate further consideration and search to determine the applicability of additional art which would render the amended claims anticipated or obvious under 35 US 102 and/or 103. Also brand new search would have to be conducted for the newly presented claims 68-71 which makes or employs as reactant a specific piperazine compound not even within the scope of claims previously examined as claim 68 is an independent claim. Even if the amendment was entered the par. one rejection under 35 USC 112 would still remain. Applicants appear to dismiss the examiner's concerns and case law raised in previous actions and do not otherwise indicate how the claims as now amended overcomes the rejection. Note the following passage in *In re Howarth* (210 USPQ 689) regarding compliance with 35 USC 112, par. one at p.690: "Applicant's risk in leaving anything out of his application... burden rests upon applicant who chooses to rely upon general knowledge in art to render his disclosure enabling to establish that

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those of ordinary skill in the art can be expected to possess or know where to obtain this knowledge;” .

**Any inquiry concerning this communication should be directed to Emily Bernhardt at telephone number (703) 308-4714.**

**A facsimile center has been established for Group 1600. The hours of operation are Monday through Friday, 8:45 AM to 4:45 PM. The telecopier numbers for accessing the facsimile machine are (703) 308-4556 or (703) 305-3592.**

  
**EMILY BERNHARDT**

**PRIMARY EXAMINER**

**GROUP 1600**